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10/595,524	04/26/2006	Zvi Barzilai	142 06 01 NP US	2186
36131	7590	06/22/2010	EXAMINER	
YORAM TSIVION			COMSTOCK, NATHAN	
P.O. BOX 1307				
PARDES HANNA, 37111			ART UNIT	PAPER NUMBER
ISRAEL			1783	
			NOTIFICATION DATE	DELIVERY MODE
			06/22/2010	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No.	Applicant(s)
	10/595,524	BARZILAI, ZVI
	Examiner	Art Unit
	NATHAN E. COMSTOCK	1783

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 15 March 2010.
 2a) This action is **FINAL**. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1 and 3-7 is/are pending in the application.
 4a) Of the above claim(s) 6-7 is/are withdrawn from consideration.
 5) Claim(s) _____ is/are allowed.
 6) Claim(s) 1, 3-5 is/are rejected.
 7) Claim(s) _____ is/are objected to.
 8) Claim(s) 6-7 are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on 15 March 2010 is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ . |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____. | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| | 6) <input type="checkbox"/> Other: _____ . |

DETAILED ACTION

Response to Amendment

1. The amendment filed 15 march 2010 is acknowledged. Claims 1 and 2-7 are pending. Claims 6-7 are withdrawn (see election/restriction below). Claims 1 and 3-5 have been amended. Claims 6-7 are new. Claim 2 has been cancelled. All Objections and Rejections made in the previous Office Action that are not repeated are withdrawn.

Election/Restrictions

2. Newly submitted claims 6-7 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: Claims 1 and 3-5 (hereinafter “Group I”) are drawn to a board. Claims 6-7 (hereinafter “Group II”) are drawn to a method for producing a board. Groups I and II do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: All of the common technical features of Groups I and II are disclosed in US PGP 2004/0043682 to Taylor et al., as discussed below in the 35 U.S.C. 102/103 rejection of claims 1-5, infra.

3. Since Applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 6-7 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Drawings

4. A replacement drawing sheet was received 15 March 2010. These drawings are not acceptable.

5. The drawing amendment filed 15 March 2010 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: in FIG. 4, the step of applying a second layer of coating is listed as optional; the application as filed included no disclosure that the step of applying a second layer of coating was optional.

6. Applicant is required to cancel the new matter in the reply to this Office Action.

Specification

7. The amendment filed 15 March 2010 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows:

8. In paragraph [0011], as amended, the statement that the perimeter of the dome like protrusions is defined by the mesh configuration. The application as filed includes no disclosure of how the perimeter of the domes is defined, or how the shape/perimeter of the domes might correspond to a shape of the mesh. The only disclosure of how the mesh and the domes might be related is present in FIG. 3, however, FIG 3 is a cross-sectional view which would not convey to one of ordinary skill in the art any information about the shape of the perimeter of the domes and/or the configuration of the mesh, or how the perimeter of the domes is related to the shape of the mesh, if at all at any point in the two-dimensional expanse of the mesh except at the particular point at which the cross-section is shown. As such, the disclosure of FIG 3 is

insufficient to support the limitation that the perimeter of the dome like protrusions is defined by the mesh configuration.

9. In paragraph [0033], as amended, the step of applying the second layer of coating is listed as optional. The application as filed included no disclosure that the step of applying the second coating was optional. Additionally, the method of producing a construction board in amended paragraph [0015] omits the applying a second coating step. The method without this step is not supported by the application as filed.

10. Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 112

11. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

12. Claims 1 and 3-5 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Specifically, as amended, claim 1 recites that the coating layer comprises dome like protrusions whose perimeter is defined by the mesh configuration. The application as filed includes no disclosure of how the perimeter of the domes is defined, or how the shape/perimeter of the domes might correspond to a shape of the mesh. The only disclosure of how the mesh and the domes might be related is present in FIG. 3, however, FIG 3 is a cross-sectional view which would not convey to one of ordinary skill in the art any information about the shape of the

perimeter of the domes and/or the configuration of the mesh, or how the perimeter of the domes is related to the shape of the mesh, if at all at any point in the two-dimensional expanse of the mesh except at the particular point at which the cross-section is shown. As such, the disclosure of FIG 3 is insufficient to support the limitation that the perimeter of the dome like protrusions is defined by the mesh configuration.

13. Claims 3-5 fail to comply for the same reasons as claim 1.
14. Claim 6 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Specifically, claim 6 omits the method step of applying a second coating after layering the mesh. The application as originally filed does not disclose that this step may be omitted (the disclosure as filed was present in paragraphs [0030]-[0035], and only includes all 4 steps).
15. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
16. Claims 1 and 3-5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
17. Claim 1 recites that the coating layer comprises dome-line protrusions whose perimeter is defined by the mesh configuration. First, it is unclear what might constitute a “mesh configuration.” Is the mesh configuration the shape of the apertures in the mesh, a variable thickness of the mesh (such as that caused by orthogonally aligned strands crossing), some

texture or shape into which the mesh is formed (such as the mesh being corrugated in some fashion), or something else? Second, it is unclear how the mesh corrugation defines the perimeter of the dome like protrusions. Does texture on the surface of the mesh cause the protrusions to extend upward, or do thickness variations push the protrusions upward, or do the edges of the apertures delimit the respective perimeters of protrusions, or something else. For purposes of examination, the mesh configuration will be construed as some organizational aspect of the mesh, and the mesh corrugation defining the perimeter of the domes will be construed as the perimeter of the domes being in some way related to the organizational aspect of the mesh.

18. Claims 3-5 are unclear at least for the reasons of claim 1.

Claim Rejections - 35 USC § 102/103

19. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

20. Claims 1 and 3-5 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over US PGP No. 2004/0043682 to Taylor et al.

21. Taylor discloses a composite tile backerboard 10 (corresponding to Applicant's board for the construction industry) comprising a core 18 (corresponding to Applicant's base board) of expanded polystyrene (corresponding to Applicant's base board made of plastic; polystyrene is a plastic/Applicant's base board made of expanded polystyrene beads), a top portion 12 of a woven mesh fabric (corresponding to Applicant's mesh) and cement compound 16

(corresponding to Applicant's coating layer/coating layer comprising cement), which together form a mesh fabric layer (corresponding to Applicant's mesh disposed within said coating layer) (paragraph [0022] and FIGS. 1-2).

22. The mesh fabric is coated with enough cement compound slurry to adhere it to the polystyrene layer and yet still leave a textured surface (paragraph [0024]). As can be seen in FIG. 2, the provision of slurry as described in paragraph [0024] leaves the upper surface of the top portion 12 with a textured surface with what appear to be small dome-shaped protrusions protruding from the coating layer over where the individual fibers of the mesh are located (i.e. the perimeter of the domes is defined by the interstices of the mesh fibers (corresponding to Applicant's coating layer comprising dome-line protrusions whose perimeter is defined by the mesh configuration).

23. With respect to claim 5, the cement slurry may comprise non-shrink additives (corresponding to Applicant's coating including additives) to minimize the shrinking of the slurry, and may comprise polymers to increase adhesion between the slurry and the mesh (corresponding to Applicant's coating including plastic adhesives) (paragraph [0027]).

24. Therefore, claims 1 and 3-5 are rejected as anticipated by, or in the alternative, obvious over, the cited art.

Response to Arguments

25. Applicant's arguments with respect to claims 1 and 3-5 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

26. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).
27. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.
28. Any inquiry concerning this communication or earlier communications from the examiner should be directed to NATHAN E. COMSTOCK whose telephone number is (571) 270-1133. The examiner can normally be reached on Monday through Thursday, 9am-6pm Eastern Standard Time.
29. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Sample can be reached on (571) 272-1376. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

30. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/David R. Sample/
Supervisory Patent Examiner, Art Unit 1783

/N. E. C./
Nathan E. Comstock
Examiner, Art Unit 1783
15 June 2010